

REMARKS

1. In response to the Office Action mailed September 20, 2006, Applicants respectfully request reconsideration. Claims 1-32 were last presented for examination. In the outstanding Office Action, claims 1-8, 13-24 and 29-32 were rejected and claims 9-12 and 25-28 were objected to. By the foregoing Amendment, no claims have been amended, added, or canceled in this paper. Thus, upon entry of this paper, claims 1-32 will remain pending in this application. Of these thirty-two (32) claims, five (5) claims (claim 1, 22, 24, 31 and 32) are independent. Based on the following Remarks, Applicants respectfully request that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

Art of Record

2. Applicants acknowledge receipt of form PTO-892 identifying additional references made of record by the Examiner.
3. Applicants acknowledge receipt of the form PTO/SB/08A filed by Applicant on July 19, 2006, which has been initialed by the Examiner indicating consideration of the references cited therein.

Drawings

4. Applicants note with appreciation the Examiner's indication that the drawings filed on June 23, 2006 have been accepted for examination purposes.

Allowable Subject Matter

5. Applicants note with appreciation the Examiner's indication that claims 9-12 would be allowable if rewritten in independent form including all imitations of the base claim and any intervening claims. Additionally, Applicants note with appreciation the Examiner's indication that claims 25-28 would be allowable if rewritten in independent form including all imitations of the base claim and any intervening claims and amended to overcome the rejections under 35 U.S.C. §101.

Claim Rejections under 35 U.S.C. §101

6. Independent claim 24 and dependent claims 25-29 have been rejected under 35 U.S.C. §101 because the claimed invention is allegedly directed to non-statutory subject matter. Applicants respectfully disagree with the Examiner and request that the Examiner reconsider and withdraw the rejection for at least the below discussed reasons.

7. “The burden is on the USPTO to set forth a *prima facie* case of unpatentability.” (See, MPEP at §2106; *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (“The examiner bears the initial burden . . . of presenting a *prima facie* case of unpatentability.”) To establish a *prima facie* case of unpatentability, the Examiner must identify and explain in the record the basis for why a claim is for an abstract idea with no practical application. See, e.g., *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995); see generally MPEP Sec. 2107 (Utility Guidelines). Additionally, “if USPTO personnel determine that the claimed invention preempts a 35 U.S.C. 101 judicial exception, they must identify the abstraction, law of nature, or natural phenomenon and explain why the claim covers every substantial practical application thereof.” (See, MPEP at §2106(IV)(c)(3).)

8. In the present Office Action, however, the Examiner has failed to identify the mathematical formula or abstract idea. Further, not only did the Examiner not identify the abstract idea or mathematical formula, it is unclear whether the Examiner is asserting that claim 24 claims a mathematical formula or an abstract idea. For example, on page 2 of the Office Action the Examiner cites to *In re Warmerdam* for holding that a process that consists solely of the manipulation of an abstract idea is not concrete and tangible. (See, Office Action at 2.) The Examiner also cites *Flook* for holding that one cannot patent a novel useful mathematical formula. (See, Office Action at 2.)

9. As such, Applicants respectfully request that the Examiner reconsider and withdraw the rejection for at least the reason that the Examiner has failed to identify the abstraction, law of nature, or natural phenomena, nor has the Examiner explained why the Examiner believes the claim covers every substantial practical application thereof.

10. Applicant further respectfully submits that independent claim 24 satisfies the requirements of §101 for at least the following additional reasons. Independent claim 24 is directed to a method and 35 U.S.C. §101 expressly states that processes are patentable

subject matter. (*See*, 35 U.S.C. §101.) Claim 24 further recites actual tangible (i.e., physical) steps such as intercepting a signal and generating a signal. Additionally, claim 24 specifically recites that the generated signal indicative of the absence of faults is useful in masking intercepted fault signals. Applicants' specification further discloses the usefulness of masking intercepted fault signals. For example, Applicants specification discloses "mask[ing] selected faults during margin testing in order to ensure that automatic response fault mechanisms integrated into the computer system ... would not adversely affect margin testing of the system." (*See e.g.*, Applicants' Specification at pg. 12 Ins 4-7.) As such, claim 24 is directed to a practical application and accordingly satisfies the requirements of §101.

11. Applicants, therefore, respectfully assert that independent claim 24 and dependent claims 25-29 are directed to statutory subject matter. As such, Applicants respectfully request that the Examiner reconsider and withdraw the rejection to claims 24-29.

Claim Rejections under 35 U.S.C. §102(e) and §103

12. Independent claims 1, 22, 24, 31 and 32 and dependent claims 2-8, 13, 15-17, 29 and 30 have been rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,546,507 to Coyle, *et al.* (hereinafter, "Coyle") Dependent claim 14 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Coyle in view of U.S. Patent No. 5,119,021 to Taraci, *et al.* (hereinafter, "Taraci"). Dependent claims 18-21 and 23 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Coyle in view of U.S. Publication No. 2003/0101020 A1 to Hawkins, *et al.* (hereinafter, "Hawkins"). Based upon the following Remarks, Applicants respectfully request reconsideration and withdrawal of these rejections.

13. Independent claim 1 recites "a margin testing system for margin testing one or more components of an electronic system, comprising:

a fault bypass module incorporated in said electronic system, said fault bypass module configured to intercept at least one signal indicative of one or more faults associated with one or more of said components during margin testing of said electronic system and mask the at least one signal indicative of one or more faults by generating at least one signal indicative of absence of the one or more faults." (*See*, Claim 1 above.)

14. In rejecting claim 1, the Examiner asserted that Coyle discloses a fault bypass module as claimed. Applicants respectfully disagree for at least the following reasons.

15. Coyle is directed to a system for testing and tuning a bus connecting electronic devices. (*See*, Coyle at col. 6 lns. 37-39.) In rejecting independent claim 1, the Examiner relied on the first failure capture module 2506 of Coyle as allegedly disclosing a fault bypass module as recited by claim 1. Coyle discloses that this first failure capture module 2506 identifies first failure conditions and captures attendant error related operating information at the time of the first failure. (*See*, Coyle at col. 35 lns. 18-30.)

16. In the Office Action, the Examiner asserted that FIGs. 28C, 28D, and col. 39 line 32 – col. 40 line 12 of Coyle allegedly disclose the first failure capture mode 2506 generating at least one signal indicative of the absence of a fault. (*See*, Office Action at 4.) These Figures and portion of Coyle disclose a method for establishing a baseline value for a signal parameter in a bus system. (*See*, Coyle at col. 39 lns. 42-44.) This method starts by testing whether the system operates correctly at a given initial value. (*See*, Coyle at col. 39 lns. 44-47.) If so, the initial value is adjusted and the system tests the new value. (*See*, Coyle at col. 39 lns. 49-52.) This process then repeats until a value is reached where the system fails. (*See*, Coyle at col. 39 lns. 52-55.) The value is then reset to the initial value and the system is tested again. (*See*, Coyle at col. 39 lns. 55-57.) If the system passes, the initial value is then adjusted in the opposite direction that it was initially adjusted. (*See*, Coyle at col. 39 lns. 57-65.) The system is then retested at this new value and if the system passes the value is adjusted again until a system failure is detected. (*See*, Coyle at col. 39 lns. 65 col. 40 ln. 1.) The system then determines the average of the highest value and lowest value for which the system passed. (*See*, Coyle at col. 40 lns. 1-4.) The system is then tested at this average value, and if it passes the method is finished. (*See*, Coyle at col. 40 lns. 4-7.) If it fails, then a system failure is determined. (*See*, Coyle at col. 40 lns. 5-6.)

17. As such, contrary to the Examiner's assertion, this portion of Coyle does not teach or suggest intercepting a fault signal and generating a signal indicative of the absence of said fault. Rather, this portion merely discloses a method for determining the highest value and the lowest value for which the system passes and then determining an intermediate value for the system to use in operations.

18. Applicants therefore respectfully submit that Coyle fails to teach or suggest “a fault bypass module configured to intercept at least one signal indicative of one or more faults ... and mask the at least one signal indicative of one or more faults by generating at least one signal indicative of absence of the one or more faults,” as recited by claim 1. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claim 1 for at least this reason.

19. In addition, contrary to the Examiner’s assertion, the method illustrated by FIGs. 28B and 28C of Coyle is not performed by the first failure capture module 2506 of FIG. 25. Rather, Coyle discloses that the method illustrated by FIGs. 28B and 28C is performed by FIG. 25 as a whole and that the first failure capture module 2506 merely identifies first failure conditions and captures attendant error related operating information at the time of the first failure. (*See*, Coyle at col. 35 lns. 18-30; *also see*, col. 37 lns. 61-64.) As such, Coyle does not teach that the first failure capture module 2506 performs all the steps illustrated in FIG. 28, but merely discloses that it identifies first failure conditions.

20. As such, Applicants respectfully submit that claim 1 is allowable over Coyle for the additional reason that Coyle fails to teach or suggest “a fault bypass module configured to... mask the at least one signal indicative of one or more faults by generating at least one signal indicative of absence of the one or more faults,” as recited by claim 1. Applicants therefore respectfully request that the Examiner reconsider and withdraw the rejection of claim 1 for at least this additional reason.

21. Independent claim 22 recites, in part, “a fault bypass module ... configured to intercept at least one signal indicative of one or more faults ... and mask the at least one signal indicative of one or more faults by generating at least one signal indicative of absence of the one or more faults.” As such, Applicants respectfully assert that independent claim 22 is allowable for at least one or more similar reasons to those discussed above with reference to independent claim 1.

22. Independent claim 24 recites, in part, “generating at least one signal indicative of absence of said faults, thereby masking said intercepted signals.” As such, Applicants respectfully assert that independent claim 24 is allowable for at least one or more similar reasons to those discussed above with reference to independent claim 1.

23. Independent claim 31 recites, in part, “means for masking said intercepted at least

one signal by generating at least one signal indicative of absence of said at least one fault.”
As such, Applicants respectfully assert that independent claim 31 is allowable for at least one or more similar reasons to those discussed above with reference to independent claim 1.

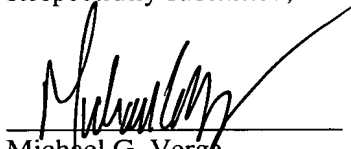
Dependent Claims

24. The dependent claims incorporate all of the subject matter of their respective independent claims and add additional subject matter which makes them *a fortiori* independently patentable over the art of record. Accordingly, Applicants respectfully request that the outstanding rejections of the dependent claims be reconsidered and withdrawn.

Conclusion

25. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

Respectfully submitted,



Michael G. Verga
Reg. No. 39,410

November 29, 2006